



**UNITED STATES DEPARTMENT OF COMMERCE**  
**United States Patent and Trademark Office**

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Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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05/018,198 03/03/00 SHAPIRO

L 114232.107

021259  
SEPPER HAMILTON  
600 FOURTEENTH STREET NW  
WASHINGTON DC 20005

HM12/0921

EXAMINER

LUKTON, D

ART UNIT

PAPER NUMBER

1653

14

DATE MAILED: 09/21/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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09/518098

EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED:

14

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Please see the attached communication regarding applicants' election.

Applicants' election (paper No. 13 , filed 8/6/01) of the second of the two required species (retrovir) is acknowledged. In response to the first of the two species, applicants have not elected a specie; instead applicants have offered, as a response, the genus of compounds which exhibit activity that is in some manner similar to, or "like" that of *alpha*-1-antitrypsin. However, this is not a compound; it is a genus of infinite size. Applicants have argued, in effect, that an examiner could readily examine a genus of infinite size. However, anyone familiar with the search and examination process would see that a genus of infinite size would impose an "undue burden". Applicants have also argued that since none of claims 40-42 recite specific compounds, they therefor do not encompass any compounds. This argument is clearly misleading. There is nothing to prevent applicants, at any time during prosecution, to add claims that are subgeneric to the group 13 claims, and which recite specific compounds.

Applicants' amendment filed 8/6/01 is held non-responsive. The time for response (one month) is reset pursuant to this Office action. An election of a compound that falls within the scope of Group 13, and which, at the same time, meets applicants requirements for a compound which exhibits "AAT-like activity" is required. Failure to elect such a species in response to this Office action will result in ABANDONMENT of the application.

Serial No. 09/518,098  
Art Unit 1653

-3-

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**DAVID LUKTON**  
**PATENT EXAMINER**  
**GROUP 1800**